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08/935,116	09/22/1997	DAVID W. DEATON	DEATON-18-USC1	8230
31518	7590	07/21/2009	EXAMINER	
NEIFELD IP LAW, PC			ALVAREZ, RAQUEL	
4813-B EISENHOWER AVENUE				
ALEXANDRIA, VA 22304			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 08/935,116  
Filing Date: September 22, 1997  
Appellant(s): DEATON, DAVID W.

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Richard Neifeld  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/26/09 appealing from the Office action mailed 11/26/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

This application was involved in an interference with O'Brien, interference 104,607. Deaton was elected by the joint assignee. A copy of the judgment is attachment 1 in the appendix.

This application was the subject of a prior appeal, appeal docket no: 2004-0786. A copy of the DECISION ON APPEAL in appeal docket no: 2004-0786 is attachment 2 in the appendix.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,882,675                    NICHBERGER ET AL.                    11-1989

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Nichtberger et al. (4,882,675 hereinafter Nichtberger).

With respect to claims 8-15, Nichtberger teaches a system for accumulating customer transaction data at the point of sale in a retail establishment and for effectuating customer promotion (abstract). A terminal for entering unique customer identification codes from customer identification presented at the point of sale in a retail transaction (col. 17, lines 30-48); means for allowing entry of customer transaction data (col. 17, lines 49-60); a processor and a memory responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code (col. 12, lines 16-32); circuitry responsive to said processor, memory, and a database for generating a customer information response signal at the point of sale during said individual customer's transaction in said retail establishment

upon detection of a unique identification code of said individual customer (col. 11, lines 46-50 and col. 18, lines 49-61); said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit (col. 17, lines 49-61); and said signal providing information at said point of sale terminal derived from said database and useful for effectuating targeted customer promotion (col. 17, lines 49-61).

Claims 17-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger in view of Official Notice.

Claims 17-41, 49-76 differ from claims 8-15 in that the claims further recite a database of prior customer purchases including the dollar amount of the purchases during an specified time period. Nichtberger teaches storing in a database the details the previous purchases/transactions information (col. 12, lines 16-32). Nichtberger doesn't specifically identify the retrieved information as being the dollar amount of the purchases. Official Notice is taken that a database of prior purchases would have been obvious to include the dollar amount of the purchases in order to allow the system to keep track of the amount spent by the customers during an specified time period and will allow coupons to be targeted based on the amount spent during an specified period. For example, customer A might spent more money during the holidays and will receive coupons accordingly. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the database of customer

previous purchases of Nichtberger the dollar amount in order to obtain the above mentioned advantage.

Claims 42-48 further recite a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases. Official Notice is taken that it obvious and well known for local stores to transmit information to a host server in order for the information to be shared. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases in order to obtain the above mentioned advantage.

#### **(10) Response to Argument**

Appellant argues that Nichtberger's CDR 20 is not a point of sale terminal and is not at a point of sale location. The Examiner wants to point out that the Examiner never cited CDR 20 for generating a customer information response signal at the point of sale during said individual customer's transaction in said retail establishment. The Examiner instead had pointed out to col. 17, lines 29-47, which teaches "**At the checkout counter, the customer presents his special card ...before the checkout process begins.. the special card also bears the customer number in UPC bar code format, it can be read automatically by the store's scanning system....The UPC codes of items customer purchased are scanned or key-entered**" As can seen by

above, Nichtberger clearly teaches that the customer information is entered and from the information entered by the customer's card at the point of sale (checkout) during the customer's transaction at a retail establishment, the corresponding list of coupons are presented or displayed.

Appellant argues that *Nichtberger's customers prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons but does not indicate that "Nichtberger ... teach[es] a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the current shopping visit.* The Examiner disagrees with Appellant because at the checkout (POS) the customer presents his/her **Special card 56**, the special card stores all customer's coupon selection (coupon selection file update 62) and customer shopping history 68 (see Figure 4 and col. 30, lines 1-6). The special card is presented at the checkout which contains customer's purchases and coupon's selection, this information is read by the checkout (POS). As can be seen by Figure 4, the signal of purchases are transmitted at the POS (checkout) by the special card which contains and stores items purchased by the customers and coupons selections. The special card is currently updated with buying transactions 72 which eventually will become prior transactions after the transaction has been taken place/scanned and this prior information is passed on to the checkout 70 at the time of purchase.

With respect to Appellant's arguments pertaining to Nichtberger not having a POS, the Examiner is baffled by such an argument. Nichtberger clearly teaches

proceeding to checkout at step 70 in order to buy/purchase the items, how can that not be a POS?

Appellant argues that Nichtberger doesn't teach generating a customer information response signal at the Point of Sale. The Examiner disagrees with Appellant because Nichtberger teaches the customer identifying himself/herself by presenting his/her special card at the checkout (see col. 17, lines 29-47).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the customer need take no action he or she otherwise would not take) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues that Nichtberger's system doesn't teach automatically responding to a customer purchases of goods in a store. The Examiner disagrees with Appellant because Nichtberger teaches that the coupons displayed are based on previous transactions (col. 18, lines 20-41).

Appellant argues that Nichtberger doesn't teach a signal transmitted to the point of sale that is related to the customer's transaction data in shopping visits prior to the

current shopping visit. The Examiner disagrees with Appellant because Nichtberger teaches that based on the customer's prior or previous purchases, buying habits of the users, etc. is used to target new offers or coupons. The redemption and buying habits are recorded in database 420 and is used by processor operations center 16 and passed on to the retailers and manufacturers in order for them to analyze buying habits, coupons redemptions and demographic (col. 18, lines 20-41).

With respect to the Official Notice taken on claims 17-41 and 49-76 pertaining to storing the dollar amount of the transactions. The Examiner wants to point out that Nichtberger teaches storing transaction information and buying habits (col. 18, lines 20-41). Nichtberger is silent as to the specific of the transaction information and the buying habits that are stored but it is old and well known for transaction information to include such things as the items purchased, amount spent (i.e. dollar mount) and the like and therefore it would have been obvious in order to customize offers based on the volume of purchases made by the customer.

With respect to the Official Notice taken on claims 42-48 pertaining to a first database at said first retail store, a second database at said second retail store and a global database for storing prior transactions from said first and second databases. The Examiner had taken Official Notice that storing information form multiple databases into a global database such as a server is well known in order for the information to be shared. Appellant argues the Official Notice is improper. The Examiner makes a general statement as to the known practice of storing information from multiple databases into a global database (server). But, nothing in this known practice

Art Unit: 3688

of storing information from different databases into a global database prohibits it from being applied to a retail store and for storing prior customer's transactions.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

Attachment 1 is a copy of the judgement in the interference 104607 involving this application. Attachment 2 is a copy of the DECISION ON APPEAL in appeal docket no: 2004-0786.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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